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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,131	05/29/2007	Alex Blijevsky	P-6259-US	1153
49443	7590	07/01/2011		
Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036			EXAMINER SMITH, PHILIP ROBERT	
			ART UNIT 3779	PAPER NUMBER
			NOTIFICATION DATE 07/01/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@pczlaw.com
Arch-USPTO@pczlaw.com

Office Action Summary

Application No.

10/585,131

Applicant(s)

BLIJEVSKY, ALEX

Examiner

PHILIP SMITH

Art Unit

3779

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-10,15,16,18,20-23 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,4,5,7-10,15,16,18,20-23 and 30-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election of Species According to the Figures

- [01] This application is directed to the following patentably distinct species:
- [01a] the method shown in Figure 3A;
 - [01b] the method shown in Figure 3B.
- [02] The species are independent or distinct because they
- [02a] do not overlap in scope. See MPEP §806.04(b).
 - [02b] are mutually exclusive. See MPEP §806.04(f).
 - [02c] In addition, these species are not obvious variants of each other based on the current record.
- [03] The methods of Figure 3A and Figure 3B differ with respect to the arrangement of elements necessary for their respective implementation. The convention capsule endoscope has an imaging element and an illumination element arranged behind an optical window. The method of Figure 3A requires a light detector outside of the optical window, located elsewhere on the capsule body, in order to be implemented. The method of Figure 3B requires a light emitter outside of the optical window, located elsewhere on the capsule body, in order to be implemented.
- [04] Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
- [05] There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

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- [05a] the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).
- [06] Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
- [07] The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.
- [08] Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

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- [09] Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Restriction

- [10] Restriction to one of the following inventions is required under 35 U.S.C. 121:

[10a] the apparatus of claims 1,4-5,7-10,15-16,30-34;

[10b] the method of claims 18,20-23,35-37.

- [11] The inventions are distinct because of the following reason:

[11a] Inventions [10a] and [10b] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, [10a] can be used to practice the method of Figure 3A or the method of Figure 3B, which are materially different processes.

- [12] Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

[12a] the inventions have acquired a separate status in the art in view of their different classification.

[12b] the inventions have acquired a separate status in the art due to their recognized divergent subject matter.

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- [12c] the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).
- [13] Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.
- [14] The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.
- [15] Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Telephonic Election

- [16] A telephone call was made to to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant has requested a fuller explanation of the restriction requirement.

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- [17] Applicant has suggested that the recited system and the recited method are not divergent and that the restriction requirement is therefore improper. Yet Applicant's attention is directed to the independent claims (of which there are two), while Examiner's attention is directed toward the Application as a whole (consisting of an apparatus that may be implemented in accordance with two distinct methods of use).
- [18] In this case, the method of claim 18 is broadly drafted so as to encompass two divergent methods (that of Figure 3A and that of Figure 3B). The method of claim 18 recites the provision and use of various elements, whereas the system of claim 1 merely recites those very same elements. Applicant's position seems to be that the claims are therefore not restrictable.
- [19] MPEP §806.05(e) states, in part, that a method and apparatus can be shown to be distinct invention if "the apparatus as claimed can be used to practice another materially different process." By virtue of its broadness, claim 18 certainly encompasses at least the two different processes that are disclosed in the application. Moreover, Applicant's own claims (e.g., 36-37) are evidence that claim 18 encompasses materially different processes. The apparatus of claim 1 is certainly able to practice the method of claim 37 (drawn to the method of Figure 3A). The apparatus of claim 1 is certainly able to practice the method of claim 36 (drawn to the method of Figure 3B).
- [20] In the instant case, Applicant has accommodated the restriction process by disclosing two materially different processes within the specification. But MPEP §806.05(e) does not even require the materially different process be disclosed *by the Applicant*. If the apparatus *as claimed* can be used to practice *any* materially different process known in the art, then it is restrictable from the recited method. In this sense, the broadness of the independent claim lends itself to various known processes. For example, consider an endoscope having an infrared photodetector, wherein an IR

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emitter array located outside the body can be used to localize the endoscope's change in position, i.e., movement from a first-diameter lumen to a second-diameter lumen. Consider also a processor that uses image processing to assess such a movement. Both methods are materially different from the recited methods, and both are practicable with the apparatus of claim 1.

Conclusion

[21] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen, can be reached on (571) 272 4963. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/
Primary Examiner, Art Unit 3779